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In re Application of	:	OFFICE OF PETITIONS
Victor R. Sanchez, Alberto	:	
Ceja, and Rigoberto Anguiano	:	
Application No. 09/753,171	:	
Filed: December 29, 2000	:	DECISION ON PETITION
Attorney Docket Number:	:	
CAS1PAU24R2	:	
Title: METHODS FOR HANDLING	:	
MASA	:	

This is in response to the petition under 37 C.F.R. §1.47(a), filed August 31, 2005.

A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - (a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - (b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 C.F.R. §1.63.

The above-identified reissue application was filed on December 29, 2000, identifying Victor R. Sanchez, Alberto Ceja, and Rigoberto Anguiano as joint inventors. Messrs. Ceja and Sanchez have not executed the reissue declaration. A copy of the reissue declaration and a complete copy of the application was sent to each of these individuals, and neither has responded. As such, it has been determined that each has refused to join in the present reissue application, and consequently, each of these inventors is deemed to be unavailable.

With this petition, Petitioner has submitted the petition fee¹, the surcharge, the last known addresses of the non-signing joint inventors, and proof that a copy of the entire application was sent to their last known addresses.

As such, Petitioner has met requirements (1) - (4) of 37 C.F.R. §1.47(a). Regarding the declaration which was submitted with the present petition however, it cannot be accepted at this time.

37 CFR §1.172 sets forth, in pertinent part:

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

MPEP §1412.04(II) sets forth, in pertinent part:

Where a reissue to correct inventorship also changes the claims to enlarge the scope of the patent claims, the signature of all the inventors is needed. However, if an inventor refuses to sign the reissue oath or declaration because he or she believes the change in inventorship (to be effected) is not correct, the reissue application can still be filed with a petition under 37 CFR 1.47 without that inventor's signature **>provided the written consent of all owners/assignees as required by 37 CFR 1.172(a) is also submitted. In the situation where a patent to inventors X and Y has no assignee and a reissue application is filed by inventor Y to delete the name of inventor X as an inventor and to broaden the patent. Inventor X refuses to sign the reissue oath or declaration and refuses to provide the consent as required by 37 CFR 1.172(a).

¹ The petition fee has been charged to Petitioner's Deposit Account, as authorized in the petition.

In this instance, a 37 CFR 1.47 petition would not be appropriate to permit the filing of the reissue application since the consent requirement of 37 CFR 1.172(a) for each owner/assignee is not met. Resort to the courts would be required to delete the name of inventor X as an inventor where X will not consent to the filing of a reissue application. As stated in the second paragraph of 35 U.S.C. 256, "[t]he court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly."

The electronic file has been reviewed, and it does not appear to contain an executed assignment from these inventors. Furthermore, the Office's Patent Application Location and Monitoring (PALM) records have been reviewed, and it does not appear that an assignment was ever recorded in the Office. As such, it does not appear that the written consent of an assignee of the entire interest (or all of the assignees, if there are multiple assignees) has been provided.

Any reply must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.47(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

Petitioner may wish to include a statement under 37 C.F.R. §3.73(b) with the renewed petition.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail², hand-delivery³, or facsimile⁴.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

² Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

³ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

⁴ (571) 273-8300- please note this is a central facsimile number.